



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,588	08/17/2001	James T. Panttaja	018167-003800US	5221

6449 7590 11/02/2006

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

LAстра, DANIEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,588

Applicant(s)

PANTTAJA ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-8, 10-19 and 21 have been examined. Application 09/932,588 (Redemption System for Award Redemption) has a filing date 08/17/2001.

Response to Amendment

2. In response to Final Rejection filed 07/18/2006, the Applicant filed an Amendment a Request for Reconsideration on 09/18/2006.

Specification

3. The disclosure is objected because the following items are not understood: page 12, lines 1-4 mentions that awards corresponding to row 338 were earned at business "5" according to promotion "1". However, Applicant's figure 3 shows that awards corresponding to row 340 were earned at business "5" and awards corresponding to row 338 were earned at business "4". Then, according to Applicant's figure 4, the awards earned in row 340 are not encumbered, however, Applicant's specification page 12, lines 1-4 mentions that awards in row 340 are the most encumbered. Proper correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites " wherein the type of award includes according to which promotion the award was earned". For purpose of art rejection, said limitation

Art Unit: 3622

would be interpreted as giving customer special awards if said awards are earned in special periods.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 8, 10-13, 15-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda (US 5,937,391).

As per claim 1, Ikeda teaches:

A method in a redemption system for determining which awards to redeem, the method comprising:

maintaining an award history database that includes award transaction information that describes awards earned by a consumer and, for each earned award, the type of award (see figure 8);

maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers (see figure 9). Applicant's specification defines that points is a type of award (see Applicant's specification page 8, lines 7-10) and in Ikeda, points awards earned in shop A cannot be redeemed in shop E (see col 8, lines 1-25; figure 9) and therefore, are encumbered.

receiving a request to redeem an amount of the earned awards at a chosen supplier (see figure 13);

Art Unit: 3622

determining allowed awards that can be redeemed with the chosen supplier (see figure 16; see column 11, lines 35-50; "points are redeemed from the oldest one by priority);

determining encumbrance levels of the allowed awards based on the types of allowed awards and the data in the encumbrance database and determining which of the allowed awards to redeem based on the encumbrance levels (see figure 16; see column 8, lines 1-25; col 11, lines 50-54). Applicant's specification page 13 teaches "that encumbrance of awards is measured in terms of restrictions on redeeming the awards at certain suppliers". Ikeda teaches a system where award points are redeemed from the oldest one by priority. However, points earned at shop B, instead of points earned at shop D, were accepted for redemption at shop B although the effective term of said points earned at shop D was older than the terms of the points earned at shop B (see Ikeda col 11, lines 35-50). Therefore, Ikeda teaches an "encumbrance level" when Ikeda teaches accepting awards from one source (i.e. points earned at shop B) while rejecting awards from other sources (i.e. points earned at shop D) because the awards at the other sources (i.e. points earned at shop D) were more restricted or encumbered than the awards earned at said one source (i.e. awards earned at shop B).

As per claim 2, Ikeda teaches:

The method of claim 1 wherein determining which of the allowed awards to redeem is further based on expiration dates of the allowed awards (see figure 9 "effective term"; column 6, lines 29-39).

As per claim 3, Ikeda teaches:

The method of claim 1 wherein determining which of the allowed awards to redeem is further based on dates on which the allowed awards were earned (see figure 8, "Purchase data"; see column 8, lines 1-25; "premium points"; see figure 9).

As per claims 4 and 12, Ikeda teaches:

The method of claim 1 wherein the type of award includes according to which promotion the award was earned (see figure 8, "points"; see column 8, lines 1-25;; see figure 9; "special period points" shop F).

As per claims 5 and 13, Ikeda teaches:

The method of claim 1 wherein the type of award includes from which business the award was earned (see figure 8, "Name of Shop"; see column 8, lines 1-25; "premium points"; see figure 9; Shop F gives premium points in a special service date).

As per claims 7 and 15, Ikeda teaches:

The method of claim 1 wherein the type of award indicates a classification of the award (see column 8, lines 1-25; "premium points"; see figure 9; column 11, lines 35-50 "points are redeemed by priority from the oldest one).

As per claims 8 and 19, Ikeda teaches:

A method in a redemption system for determining which awards to redeem, the method comprising:

maintaining an award history database that includes award transaction information that describes awards earned by a consumer and including, for each earned award, an expiration date and the type of award (see figure 8);

Art Unit: 3622

maintaining an encumbrance database that describes restrictions on redeeming types of awards (see figures 8, 9). Applicant's specification defines that points is a type of award (see Applicant's specification page 8, lines 7-10) and in Ikeda, points awards earned in shop A cannot be redeemed in shop E (see col 8, lines 1-25; figure 9).

receiving a request to redeem an amount of the earned awards (see figure 13);

determining allowed awards that can be redeemed based on the expiration date and the types of awards (see figures 8 and 16; see column 8, lines 1-25; column 11, lines 35-50; points are redeemed by priority and effective term); and

determining which of the allowed awards to redeem based on the earning date (see column 6, lines 40-50; column 11, lines 35-50);

determining which of the allowed awards to redeem based on the encumbrance levels (see figure 9). Ikeda teaches a system where award points are redeemed from the oldest one by priority. However, points earned at shop B, instead of points earned at shop D, were accepted for redemption at shop B although the effective term of said points earned at shop D was older than the terms of the points earned at shop B (see Ikeda col 11, lines 35-50). Therefore, Ikeda teaches an "encumbrance level" when Ikeda teaches accepting awards from one source (*i.e.* points earned at shop B) while rejecting awards from other sources (*i.e.* points earned at shop D) because the awards at the other sources (*i.e.* points earned at shop D) were more restricted or encumbered than the awards earned at said one source (*i.e.* awards earned at shop B).

As per claims 10 and 21, Ikeda teaches:

The method of claim 8 wherein determining which of the allowed awards to redeem is further based on the types of the allowed awards. The same rejection applied to claim 8 is also applied to claim 10.

As per claim 11, Ikeda teaches:

The method of claim 8 wherein the encumbrance database describes types of awards that cannot be redeemed at one or more suppliers;

wherein receiving a request to redeem further comprises receiving an indication of a chosen supplier at which to redeem the awards; and wherein determining allowed awards is further based on the chosen supplier. The same rejection applied to claim 1 regarding this limitation is also applied to claim 11.

As per claim 16, Ikeda teaches:

The method of claim 8 further comprising:

determining encumbrance levels of the allowed awards based on the types of allowed awards and the data in the encumbrance database. The same rejection applied to claim 1 regarding this limitation is also applied to claim 16.

Claim 17 contains the same limitations as claims 2 and 3 therefore the same rejection is applied.

As per claim 18, Ikeda teaches:

The system of claim 17 wherein the first memory and the second memory are a common memory with storage areas for award transaction information and information related to types of awards that cannot be redeemed at one or more suppliers. The same rejection applied to claim 1 regarding this limitation is also applied to claim 18.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (US 5,937,391).

As per claims 6 and 14, Ikeda teaches:

The method of claim 1 wherein the type of award indicates black-out dates on which the award cannot be redeemed. However, Official Notice is taken that it is old and well known in the business art that Black-out dates is a well known practice set up by points issuers where certain special dates (i.e. thanksgiving, July 4, etc), are classified black-out dates for the purpose of not allowing customer to redeem said point issuers' products with points when said products would have a guaranteed purchaser that would purchase said products with money instead of points. For example, airlines do not allow their frequent flier customers to redeem tickets with points in certain dates (i.e. black-out dates) such as July 4, because said airlines know that due to the increase business volume caused by the special date, said airlines would have a guarantee purchaser, which would purchase said tickets with money instead of points, therefore, increasing profits to said airlines. Therefore, airlines would classified certain dates as black-out dates for the purpose of increasing profits and taking advantage of the increase of business volume on those black-out dates. Therefore, it would have been obvious to a

person of ordinary skill in the art at the time the application was made, to know that if shops in the Ikeda's system are able to change redemption ratio at special service dates, the Ikeda system would allow participating shops to indicate special black-out periods, where the point redemption ratio would be zero and points would not be accepted for redemption. For example, a special period such as a Christmas, a shop would change the point redemption ratio to zero (*i.e.* Black-out period) in order to make customer purchase said shop's products with money instead of points and therefore, take advantage of the increase business volume of said period.

Response to Arguments

7. The Applicant argues that the Examiner should consider the arguments set forth in the April 21, 2006 response, including Tables 1 and 2 because Applicant's reference to encumbrance level described in new tables 1 and 2 was merely intended to be an explanation by way of example. The Examiner answers that Applicant's Specification defines the term "encumbrance level" very broadly as simply "a measured in terms of restrictions on redeeming awards at certain suppliers" (see Specification page 13). Therefore, new tables 1 and 2 presented by the Applicant would be considered new matter, as nowhere in Applicant's original disclosure is mentioned anything about "level 1, 2" or the examples given in said tables.

The Applicant argues that Ikeda does not teach "type of awards". Furthermore, the Applicant argues that Ikeda does not teach " wherein the type of award indicates a classification of the award". The Examiner answers that Applicant's specification mentions that "points" is a "type of award" (see Applicant's specification page 8, lines 9-

Art Unit: 3622

12). Therefore, contrary to Applicant's argument, Ikeda teaches "type of awards" and classification of said type of awards which is points. The Examiner wants to mention that it is true that Ikeda does not teach "silver points" or "gold points", however, Applicant is not claiming that. Applicant is simply claiming "type of awards".

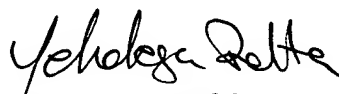
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
October 16, 2006


RETTA YEHDEGA
PRIMARY EXAMINER